

## **REMARKS**

Claims 1-34 remain pending in the Application. Reconsideration is respectfully requested.

### **Declaration Under 37 C.F.R. § 1.132**

The Declaration under 37 C.F.R. § 1.132 was submitted by a person that is neither an inventor nor an assignee of the rights to the invention. It is not clear from the Action, why the Examiner considers it relevant to know from this Declarant whether the inventors created the invention via “scratch” or customized something that was purchased. Applicants respectfully submit that the evidence of record should be more than sufficient for the Examiner to determine that the Application is allowable.

For example, it is well settled that “weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him.” *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967). Applicants respectfully submit that the Declaration provides such a statement in addition to establishing that one of ordinary skill in the art at the time of the invention would consider the applied art as being **inoperative and non-enabling** with respect to the subject matter of the claims in the present application. Thus, the Declaration provides factual evidence which disproves the pending rejections.

### **Claim Objections**

Applicants respectfully traverse the objections to claims 5 and 6 on the grounds that claim 6 is not a duplicate of claim 5. For example, claim 6 recites “a BIOS program password” as well

as “a BIOS boot password” (which is in claim 1 from which it depends). In contrast claim 5 recites “the BIOS boot password” but does not recite “a BIOS program password.”

Withdrawal of the objections to claims 5 and 6 is respectfully requested.

**Rejections Under 35 U.S.C. § 103(a)**

Claims 1-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cromer, et al., U.S. Publication No. 2002/0166072 (“Cromer”). These rejections are respectfully traversed.

Applicants’ arguments made in the Response to the Action dated August 12, 2009, are hereby incorporated by reference herein. The following arguments are directed to the additional assertions used by the Examiner to support the rejections and the additional assertions made in the “Response to Arguments” section provided by the Examiner on pages 2-7.

**Claims 1, 14, 16-17, 19-20 and 22**

Independent claims 1, 16 and 19 recite a BIOS of an automated banking machine that specifies a drive that (when detected) requires the manual input by a user of a BIOS boot password prior to booting from the drive. Also the BIOS of the automated banking machine specifies a drive that does not require the manual input by a user of a BIOS boot password prior to booting from the drive.

As acknowledged by the Examiner, in Cromer, a computer boots to a detected drive by verifying (when configured to do so) that a hash of data stored on the drive (e.g., a model and serial number) matches corresponding data stored in a BIOS (paragraph [0027]). Cromer does not disclose or suggest, (or have any apparent reason for) after detection of bootable media for

a designated drive, requiring that a user manually input a BIOS boot password in order to boot from the drive.

The Examiner now references paragraph [0022] of Cromer to allegedly show where Cromer teaches the recited manual input by a user of a BIOS boot password. However, Applicants respectfully submit that the “configuration password” discussed at paragraph [0022] does not correspond to the recited BIOS boot password. Rather the “configuration password” is simply a password that is used to enter the BIOS configuration routine. As shown in Figure 2B of Cromer, the BIOS configuration routine is a program via which a user configures the boot priority for drives and whether a drive should be interrogated during the boot process for the previously described hash of data.

As discussed in paragraph [0022] the user is always presented with the ability to enter the BIOS configuration routine simply by pressing the function key (F1) at the appropriate time, regardless of whether drives are detected by the BIOS and regardless of whether a password is required to boot from a particular drive. Thus, the configuration password of Cromer is not analogous to the boot password recited in the claims.

**Nowhere does Cromer require a user to input its configuration password responsive to the detection of a first bootable media and a determination that a manual input of a BIOS boot password is required in order to boot from the detected first bootable media.**

Also, nowhere does Cromer disclose or suggest that its hash method for interrogating a hard drive could be replaced with a user inputted password. Stating that its hash method is a “preferred embodiment” does not make it predictable for one of ordinary skill in the art to dispense with Cromer’s described hashes and to use the process recited in the pending claims.

In addition, it would not be obvious to one of ordinary skill in the art to modify Cromer in a manner that would correspond to the recited subject matter. Cromer's solution to making computers more secure and to prevent any portable unknown drive from being used to boot a computer, is to require the computer to be configured to only boot from devices that internally include data (e.g., model and serial number) that has been previously coupled to the BIOS of the computer. By calling out the disadvantage of using unknown hard disk drives (e.g., in paragraphs [0010] and [0028]), Cromer teaches away from Applicants' invention (which enables a technician to boot from a new and unknown drive/media) by teaching a system that prevents an unknown device (not coupled to a BIOS) from being booted. Further modifying Cromer as suggested in the Action to replace its hash method of coupling a drive to the BIOS, would destroy the utility and advantages of Cromer's described invention.

An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988). It follows that it would not be predictable to one of ordinary skill in the art at the time of the invention to modify Cromer as suggested in the Action. For at least these reasons, all of the rejections should be withdrawn.

### **Claims 5, 6, 32, and 33**

Based on the objection to claims 5 and 6, it appears that the Examiner may not have appreciated the differences between the recited BIOS boot password and the BIOS program password. It should be noted that Claim 6 (and Claim 33) recites both manual input of the BIOS boot password (recited in claims 1 and 22 from which they depend) and a different "BIOS

program password.” Nowhere does Cromer disclose or suggest two different distinct manually inputted passwords (one for entering a BIOS setup program; and another for determining whether to boot from a detected bootable media).

Also, nowhere does Cromer disclose or suggest a single manually inputted password (one that is used for both entering a BIOS setup program; and for determining whether to boot from a detected bootable media).

Rather as pointed out previously, Cromer only includes a user provided configuration password in order to enter a configuration routine. Cromer’s configuration password is not used to boot from a detected bootable media.

For at least these reasons, the rejections of claims 5, 6, and 32 should be withdrawn.

## **Claims 2 and 23**

With respect to claims 2 and 23, nowhere does Cromer disclose or suggest that when a bootable media of an alternative storage device drive is detected and a BIOS boot password is not inputted within a predetermined amount of time by a user, the computer is booted responsive to the boot record of the bootable media of the default storage device drive.

The Examiner’s reasoning for why this feature would be an obvious modification to Cromer is unclear. The Examiner discusses that “every ATM will abort your action if a user does not enter the password within a predetermined amount of time.” It appears the Examiner may be referring to the entry of a PIN. However, a PIN is not analogous to the hash described in Cromer which couples a BIOS to a particular drive. There is no apparent reason for one of ordinary skill in the art to replace Cromer’s use of a hash to couple a drive to a BIOS, with a PIN that times out after a predetermined amount of time. As discussed previously such a modification would

reduce the security advantages provided by Cromer's invention. Obviousness cannot be supported if the alleged modification (as is here) would destroy the utility and advantages of the reference.

For at least these reasons, the rejections of claims 2 and 23 should be withdrawn.

#### **Claims 4 and 34**

With respect to claims 4 and 34, nowhere does Cromer disclose or suggest a **cash dispenser or dispensing cash from a cash dispenser**. Further, automated banking machines having cash dispensers are not analogous to Cromer's described vulnerable unattended conventional PC. Cromer does not provide any teaching or suggestion that the physical security of an automated banking machine is inadequate, and thus does not provide any motivation to modify an automated banking machine that dispenses cash to include his described BIOS.

The Action has not established a case of *prima facie* obviousness with respect to claims 4 and 34. Further, the Action has not provided any apparent reason or rationale to modify the applied art to correspond to the subject matter recited in claims 4 and 34.

Withdrawal of the rejections of claims 4 and 34 is respectfully requested.

#### **Conclusion**

In conclusion, it was not known nor would it have been obvious to a person having ordinary skill in the art having full view of the cited references, to have produced the claimed features, relationships, and steps. Applicants respectfully submit that this application is in

condition for allowance. The undersigned is willing to discuss any aspect of the application at the Office's convenience.

Respectfully submitted,



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